

**REMARKS**

In the Office Action,<sup>1</sup> the Examiner rejected claims 1-61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,068,797 to Sansone et al. ( "*Sansone*") in view of U.S. Patent Application Publication No. 2002/0032573 to Williams et al. ("*Williams*"), U.S. Patent No. 5,072,401 to Sansone et al. ("*Sansone '401*"), and in further view of U.S. Patent No. 5,043,908 to Manduley et al. ("*Manduley*").

By this response Applicants have amended claims 1, 3-8, 15, 17-24, 29, 31-33, 35, 36, 43, 46-51, and 57-61. No new matter has been added because the amendments are supported at least by paragraphs [070], [081], and [082] of Applicants' specification. Claims 1-61 remain pending and under examination.

**Rejection of claims 1-61 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-61 under 35 U.S.C. § 103(a) as being unpatentable over *Sansone* in view of *Williams*, *Sansone '401*, and *Manduley*. No *prima facie* case of obviousness has been established at least because the cited references fail to teach or suggest all the elements of the claims, as amended.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references *can* be combined or modified does not render the resultant

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention as a *whole* would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Amended claim 1 recites a method of managing delivery carriers including, among other things, “determining, using the computer system, routes for delivery based on business rules applied to the delivery data, wherein the business rules comprise a carrier contract obligation.”

The Office Action implies that *Sansone* discloses determining routes for delivery using business rules, but fails to cite to any portion of *Sansone* in support of the implication. O.A. at 4. While *Sansone* may disclose improving the efficiency of delivery routes, this is not the same as determining routes based on business rules because no rules are applied. The Office Action also incorrectly alleges that *Sansone* suggests

determining a delivery route using contractual obligations. O.A. at 14. In particular, the Office Action alleges that adjusting staff levels and communicating with mailer and carriers is “taking into account contractual obligations.” *Id.* Applicants respectfully disagree.

*Sansone* indicates that the “Post Office may find it advantageous to increase or decrease its staff ... to plan for the handling of mail.” *Sansone*, col. 17:8-16. Rather than disclosing that staffing is increased due to a contractual obligation with a delivery carrier, *Sansone* only discloses that the Post Office might find it useful to plan for expected increased mail volume. Furthermore, communicating with mailers does not constitute a communication that is due to a contractual obligation. *Sansone* discloses that mailers may communicate with the Postal System to assist in Postal Service planning and to optimize mail batch deliveries. *Sansone*, col. 18:11-19. This neither discloses nor suggests a contract with a delivery carrier and thus cannot disclose or suggest “determining, using the computer system, routes for delivery based on business rules applied to the delivery data, wherein the business rules comprise a carrier contract obligation.”

The Office Action also does not allege that *Williams* discloses “determining, using the computer system, routes for delivery based on business rules applied to the delivery data, wherein the business rules comprise a carrier contract obligation.” Indeed, *Williams* does not disclose or suggest the above elements.

Applicants submit that *Sansone* '401 fails to cure this defect of *Sansone* and *Williams*. *Sansone* '401 discloses a system enabling more efficient and effective use of facilities at a post office. *Sansone* '401, col. 3:22-25. In particular, *Sansone* '401

discloses that a mass mailer may decide how to handle mail at a mailer's site based on different factors. *Sansone '401*, col. 9:67 - 10:8. The factors of *Sansone '401* are not business rules because they are merely considerations, not business rules applied to a set of facts. Even if the factors of *Sansone '401* constitute business rules, which Applicants do not concede, *Sansone '401* additionally fails to disclose or suggest that any of the factors comprise a carrier contract obligation. For at least these reasons, *Sansone '401* fails to disclose or suggest "determining, using the computer system, routes for delivery based on business rules applied to the delivery data, wherein the business rules comprise a carrier contract obligation," as recited by amended claim 1.

*Manduley* also fails to disclose or suggest at least the elements of amended claim 1, discussed above. The Office Action relies on *Manduley* to allegedly teach monitoring of a mail piece through the system. O.A. at 7-8. Applicants disagree with the Office Action's characterization of the *Manduley* reference. Regardless, *Manduley* fails to teach or suggest "determining, using the computer system, routes for delivery based on business rules applied to the delivery data, wherein the business rules comprise a carrier contract obligation," as recited by amended claim 1.

For at least these reasons, no reasonable combination of *Sansone*, *Williams*, *Sansone '401*, or *Manduley* discloses or suggests all the elements of amended claim 1 and the Examiner has failed to properly ascertain the differences between claim 1 and the prior art. Moreover, the above-quoted elements of claim 1 demonstrate significant differences between claim 1 as a whole and the subject matter of the cited references, and show a gap between the cited references and claim 1 that is so great as to render the claim nonobvious to one reasonably skilled in the art. See M.P.E.P. § 2141.

Although of different scope, independent claims 15, 29, 43, and 57 include similar elements as those recited in claim 1. For at least the same reasons claim 1 is nonobvious, each of independent claims 15, 29, 43, and 57 is also nonobvious over the cited references, and thus, is allowable. Dependent claims 2-14, 16-28, 30-42, 44-56, and 58-61 are also nonobvious at least by virtue of their respective dependence from independent claims 1, 15, 29, 43, and 57 as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-61.

### **CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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